UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte MARK BAGLEY and RACHEL BERRY

_____

Appeal 2009-001317
Application 09/889,349
Technology Center 2100

_____

Decided: January 13, 2010

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Before LEE E. BARRETT, JOSEPH L. DIXON, and
LANCE LEONARD BARRY, *Administrative Patent Judges.*

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

The Appellants appeal the rejected claims 1-16 and 23-54 under 35
U.S.C. § 134 (a). Claims 17-22 have been canceled. We have jurisdiction
under 35 U.S.C. § 6 (b).

We AFFIRM.

I. STATEMENT OF THE CASE

The Invention

The invention at issue on appeal relates to a method and apparatus for
managing information-bearing content files stored in directories and
template files associating the content directories to create a document (Spec.
4-5).

The Illustrative Claim

Claim 1, an illustrative claim, reads as follows:

1. A method of managing information-bearing content
files stored in a computer file system, the computer file system
being divided into directories, the method comprising:

locating one or more content files, each content file being
stored in a directory of the computer file system;

associating one or more template files with each
directory in which at least one content file is stored, each
template file being effective, when applied to the content file, to
carry out a respective pre-determined operation on the content
file; and

applying the one or more template files associated with a
given directory to each content file stored in that given
directory, wherein the respective directory in which each

content file is stored determines which of the one or more template files is applied;

wherein the applying the one or more template files associated with a given directory to each content file stored in that directory generates a corresponding templated information-bearing content file whose appearance is controlled by the one or more associated template files.

The References

Donohue	US 5,987,480 A	Nov. 16, 1999
Schultz	US 6,453,339 B1	Sept. 17, 2002
Popp	US 6,651,108 B2	Nov. 18, 2003

The Rejections

Claims 1-16, 23-30, 35-38, and 47-54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Donohue in view of Schultz.

Claims 31-34 and 39-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Donohue and Schultz, and further in view of Popp.

Only those arguments actually made by the Appellants have been considered in this decision. Arguments which the Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37 (c)(1)(vii).

II. ISSUES

Have the Appellants shown that the Examiner erred in determining that the combination of Donohue and Schultz discloses:

> [L]ocating one or more files, each content file being
> stored in a directory . . . associating one or more template
> files with each directory . . . applying the one or more
> template files associated with a given directory to each
> content file stored in that given directory, . . . wherein the
> applying the one or more template files associated with a
> given directory to each content file stored in that
> directory generates a corresponding templated
> information-bearing content file whose appearance is
> controlled by the one or more associated template files.

as recited in claim 1?

Have the Appellants shown that the Examiner erred in determining that one skilled in the art would have been motivated in combining the teachings of Donohue and Schultz?

Have the Appellants shown that the Examiner erred in determining that the combination of Donohue and Schultz discloses "if a determination is made that the directory storing the one or more of the plurality of content files also stores the one of the plurality of template files," as recited in claim 13?

Have the Appellants shown that the Examiner erred in determining that the combination of Donohue and Schultz discloses applying at least one template file associated with a parent directory of a given directory to the stored one of the multiple content files in the given directory, as recited in claim 31?

III. PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

The allocation of burden requires that the United Patent and Trademark Office (USPTO) produce the factual basis for its rejection of an

application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). The Examiner bears the initial burden of presenting a prima facie case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Appellants have the opportunity on appeal to the Board of Patent Appeals and Interferences to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

In determining obviousness, the Supreme Court states:

> Section 103 forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

The Court reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, 550 U.S. at 416. The operative question in this "functional approach" is thus

"whether the improvement is more than the predictable use of prior art elements according to their established functions." *Id.* at 415, 417.

VI. FINDINGS OF FACT

The following findings of fact (FFs) are supported by a preponderance of the evidence:

Donohue

1. Donohue discloses that a "data source may comprise any conventional type of database and database management system, provided the content stored in the database represents or is reducible to name/value pairs." (Col. 4, ll. 59-62.)

2. Donohue also discloses that a plurality of template files are stored in a hierarchical directory in the format of HTML document (fig. 3; col. 10, ll. 9-42), each template file corresponding a document which may be requested by users (col. 5, ll. 27-35). When a user requests a document, the template directory is searched and corresponding content files for the template file are retrieved by utilizing the name/pair value (col. 5, ll. 31-35; col. 6, ll. 14-33).

3. Donohue further discloses that the template directory is a hierarchical directory that a user can search from the existing directory level to its parent directories to find the template file needed (col. 5, ll. 27-51).

Schultz

4. Schultz discloses that a system and method for presenting a document to a user includes a content storage storing published content in a storage device including the local and remote storages (col. 5, ll. 32-33); a content directory 24 containing a template directory, and index 28 for meta file of published contents (figs 2, 4, and 5; abstract; col. 13, ll. 54-55; col. 4, ll. 24-

51).

5.   Schultz further discloses the appearance of the retrieved document is controlled by the template file (col. 13, ll. 60-64).

6.   Schultz also discloses associating the template file with each content directory in which "a new template directory is created in the content directory and the main active content server file is copied to the new template directory." (Col. 14, ll. 8-14.)

7.   Schultz discloses applying the one or more template files to content directory to retrieve the corresponding content files for producing a document under HTML schema (fig. 7; col. 14, l. 51-col. 15, l. 11).

V. ANALYSIS

The Appellants have elected to argue claims 1-16, 23-30, 35-38, and 47-54 together as a group (App. Br. 26). Therefore, we select independent claim 1 as the representative claim for this group, and we will address the Appellants' arguments with respect thereto.

35 U.S.C. § 103(a) rejections

With respect to claim 1, the Appellants contend that Donohue does not disclose locating one or more content files and each content file being stored in a directory of the computer file (App. Br. 27).

The Examiner "does not use the Donohue reference to teach the 'each content file being stored in a directory'. Instead, the Examiner provides the teaching of Schultz for the 'each content file being stored in a directory,' which was then applied to the system of Donohue." (Ans. 9.)

We agree with the Examiner. We find Donohue teaches that a data

source (a relationship database) stores the content files and indexes the content files as name and value pairs (FF 1) that is not a content directory. However, we also find that the Examiner cites Schultz to teach the argued limitation (Ans. 4) that a content file directory is used for easily retrieving the required content file (FF 4).

The Appellants further contend that Donohue does not teach the limitations of associating one or more template files with each directory in which at least one content file is stored and applying one or more template files associated with a given directory to each content file stored in that given directory because Donohue fails to teach the content directory (App. Br. 28-29).

We disagree with the Appellants' contentions. Where the rejection is based upon the teaching of a combination of references, as it is here, each reference must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. *See In re Merck & Co.* 800 F.2d 1091 (Fed. Cir. 1986). Here, the Appellants read Donohue in isolation without considering the obviousness rejection as applied by the Examiner, which is based on the combination of Donohue and Schultz. As discussed *supra*, the Examiner relies upon Schultz for teaching the limitation of content directory (FF 4). We also find Schultz expressly teaches that the content file is copied to the template directory (FF 6). We further find that both Donohue and Schultz teach applying the template file to content files to produce a document requested by a user (FF 2 and FF 7) and Schultz expressly mentions applying the template file to the content directory to retrieve corresponding content files (FF 7) for customized looking and feeling (FF 5).

The Appellants further contend that

> Even if the teachings of Donohue and Schultz were combined, the result would therefore be replacing the data source 12 in Donohue with an external data source (such as storage device 16 of Schultz) with internal pointers to content in the data source, although there appears no advantageous reason why this would have been considered.

(App. Br. 32.)

We disagree with the Appellants' contention. First, we find that Schultz teaches the storage 16 could be either local or remote storages (FF 4). Furthermore, the content directory of Schultz teaches an added advantage over the name/value pair index of Donohue for retrieving the content file from an enormous content file storages, and those two structures are compatible and can coexist, as evidenced by Schultz (FF 4). In our view, therefore, the combination of the teachings of Donohue with the content directory of Schultz would have been obvious to an artisan in the field to obtain the benefit of the content directory provided.

The Appellants also contend that "one of ordinary skill in the art would not have been motivated to modify Donohue to arrive at the present invention" (App. Br. 31) because "Donohue's system is to provide customized web pages based on who is requesting the web page" by populating a selected template with values from name-value pairs corresponding to the requesting user (i.e., the person submitting the URL)." *Id.* The Appellants further contends that "[e]ven if the name/value pairs of content stored in data source 12 were modified or moved to a directory structure, there is no further teaching or suggestion of applying a template to an associated part of the directory structure in which one name/value pair

may be stored." *Id.*

    We disagree with the Appellants' contentions. We find, in fact, that both Donohue and Schultz teach utilizing HTML file as a template file to produce a document/web page by using tags or other codes in the template file (FF 2 and 7). We also find that Schultz uses the meta file index 28 to facilitate searching by search engine (FF 4), which is analogous to the name/pair index of Donohue. Hence, we find that the content directory technique of Schultz does not operate contrary to the goal of Donohue. We agree with the Examiner that Schultz's content directory would enhance the performance of Donohue's system (Ans. 5). A person of ordinary skill in the art who produces a document or web pages utilizing HTML files as the template files as Donohue teaches would have obviously employed Schultz's content directory for faster retrieving the content files (FF 2, 4, and 7). We also find that the combination of Donohue and Schultz is "a design step well within the grasp of a person of ordinary skill in the relevant art" and the benefit of doing so would be obvious. *See KSR*, 550 U.S. at 427. The combination of familiar elements, for example, the document presentation system of Donohue combined with the well known content directory technique of Schultz is nothing more than a "predictable use of prior art elements according to their established functions." *Id* at 417.

    Accordingly, we sustain the Examiner's obviousness rejection of the independent claim 1. We also sustain the Examiner's obviousness rejection of the independent claims 5, 23, and 27, which have analogous limitations and are not separately argued by Appellants. Dependent claims 2-4, 6-12, 24-26, 28-30, and 47-54, which are not separately argued, fall with their base claims. 37 C.F.R. § 41.37 (c)(1)(vii). *See In re Nielson,*

816 F.2d 1567, 1572 (Fed. Cir. 1987).

With respect to claim 13, the Appellants contend neither Donohue nor Schultz teaches or fairly suggests that "directory storing the one or more of the plurality of content files also stores the one of the plurality of template files" (App. Br. 34).

We disagree with the Appellants' contention. We find Schultz teaches that the template directory is within the content directory (FF 5) and the content files are copied (stored) under the template file directory (FF 6).

Accordingly, we sustain the Examiner's obviousness rejection of the independent claim 13. We also sustain the Examiner's obviousness rejection of the independent claims 14-16, which have analogous limitations and are not separately argued.

With respect to claim 31, the Appellants contend that the combination of Donohue and Schultz fails to teach or suggest searching a parent directory of the template file child directory (App. Br. 34-35).

We disagree with the Appellants' contention. We find that Donohue expressly teaches searching a parent directory of a child directory (FF 3). We find that combining the well known element of searching and applying the template file associated with the parent directory of Donohue with the well known technique of storing content files in the template directory of Schultz is nothing more than a "predictable use of prior art elements according to their established functions." *See KSR*, 550 U.S. at 417.

Accordingly, we sustain the Examiner's obviousness rejection of the dependent claim 31. We also sustain the Examiner's obviousness rejections of its dependent claims 32-46, which have analogous wording and are not separately argued, fall with their respective base claims. 37

C.F.R. § 41.37 (c)(1)(vii). *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

VI. CONCLUSION

Based on the record before us, having weighed the evidence of obviousness found in the combined teachings of the applied references, with the Appellants' countervailing evidence and arguments for nonobviousness, we conclude that the claimed invention encompassed by appealed claims 1-16 and 23-54 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

VII. ORDER

We affirm the rejection of claims 1-16 and 23-54 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136 (a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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